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PATENT
Attorney Docket No. 020375-000240US

TOWNSEND and TOWNSEND and CREW LLP

By: _____


Cory Bennett

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Milberger et al.

Application No.: 10/021,292

Filed: October 29, 2001

For: SUBSCRIPTION-BASED PAYMENT

Confirmation No. 9347

Examiner: Colbert Ella

Technology Center/Art Unit: 3624

**SUBSTITUTE APPEAL BRIEF
UNDER 37 CFR §41.37**

MAIL STOP: APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on January 15, 2004 for the above-referenced application and in Response to the Notification of Non-Compliant Appeal Brief mailed November 3, 2006, Appellants submit this Substitute Brief on Appeal.

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1. REAL PARTY IN INTEREST

The real party in interest is First Data Corporation.

2. RELATED APPEALS AND INTERFERENCES

No other prior or pending appeals, interferences, or judicial proceedings are known that are related to, will directly affect, will be directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-27 are currently pending in the application, but stand rejected by the Examiner. Claims 1-10 and 12-20 are as originally filed in the application on October 29, 2001. Claim 11 was amended and claims 21 and 22 were added in the response to the first Office Action mailed on January 9, 2003. Claims 23-27 were added in response to the non-final Office Action that was filed June 5, 2003. No claims have been canceled.

Claims 1-27 are believed improperly rejected and are the subject of this appeal.

4. STATUS OF AMENDMENTS

There is no controversy over the status of claims 1-27 since no amendments were proposed after the final Office Action of July 15, 2003 or the subsequent Office Action ("Office Action") of September 9, 2004.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In one embodiment, the claimed invention relates to using an online money transfer system **100** to automatically process a recurring transfer request from a stored value fund. Application, claim 1. Within the online money transfer system **100**, a stored value fund is maintained that receives a transfer from any one of a number of money handlers **160** in a first transfer. Id., page 3, first full paragraph. In the transfer transaction, the payor is informed that the payee accepts payment from the online system **100**. Id., Fig. 11A, step 1104.

Subscription type information is received by the online money transfer system 100 from the payor to, for example, set rules for the recurring transfer. *Id.*, Fig. 11A, steps 1116, 1120, and 1124. Types of subscription type information include at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period. *Id.*, claim 1. For example, the automated transfer could be \$50 limit per month time period.

To initiate one of the recurring transfers, the online money transfer system 100 receives pay-out instructions from the payee when a recurring payment is due. *Id.*, Fig. 11B, step 1140. The pay-out instructions include at least two of a payor identifier, a payee identifier, a transfer amount, and a payment description. *Id.*, claim 1. With the particulars of the transfer, the payment can be automatically transferred from the stored value fund to the payee. *Id.*, claim 1; and Fig. 11B, step 1164.

Other embodiments and embellishments are possible for the invention. For example, some embodiments allow a veto period that allows the payor the ability to decline the recurring transfer submitted by the payee. *Id.*, claim 17. The payor is reminded of the transfer and a period of time is waited before the transfer is made to the payee. *Id.* Other embodiments and embellishments are, or course, still within the scope of the claimed invention.

In the embodiment of claim 1, a method for automatically processing a recurring transfer request from a stored value fund with an online system 100 is disclosed. In one step, it is determined that a handler 160 is associated with a payor 110. *Application*, Fig. 1; Fig. 6A, step 616; and page 9, lines 14-19. Money is transferred from the handler 160 to the stored value fund. *Id.*, Fig. 5A, step 536; Fig. 8; and page 13, line 23 through page 14, line 13. The payor 110 is informed that a payee 130 accepts payment from the online system 100. *Id.*, Fig. 11A, step 1104; and page 16, lines 33-34. Subscription type information is received that includes at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time

period, a limit on the number of payments in the time period, and a time period. Id., Fig. 11A, step 1116; page 17, lines 5-27. Pay-out instructions are received that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description. Id., page 17, lines 28-31, page 9, last full paragraph. The transfer amount is transferred from the stored value fund to the payee automatically. Id., Fig. 11B, step 1164; page 18, top paragraph.

In the embodiment of claim 11, a method for automatically processing a recurring transfer request from a stored value fund with an online system 100 is disclosed. In one step, it is determined that a handler 160 is associated with a payor 110. Application, Fig. 1; Fig. 6A, step 616; and page 9, lines 14-19. Money is transferred from the handler 160 to the stored value fund. Id., Fig. 5A, step 536; Fig. 8; and page 13, line 23 through page 14, line 13. The payor 110 is informed that a payee 130 accepts payment from the online system 100. Id., Fig. 11A, step 1104; and page 16, lines 33-34. Subscription type information is received that includes at least one of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period. Id., Fig. 11A, step 1116; page 17, lines 5-27. Pay-out instructions are received that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description. Id., page 17, lines 28-31, page 9, last full paragraph. The transfer amount is transferred from the stored value fund a second handler associated with the payee automatically. Id., Fig. 11B, step 1164; page 18, top paragraph.

In the embodiment of claim 17, a method for automatically processing a transfer request from a stored value fund with an online system 100 is disclosed. In one step, it is determined that a handler 160 is associated with a payor 110. Application, Fig. 1; Fig. 6A, step 616; and page 9, lines 14-19. Money is transferred from the handler 160 to the stored value fund. Id., Fig. 5A, step 536; Fig. 8; and page 13, line 23 through page 14, line 13. The payor 110 is informed that a payee 130 accepts payment from the online system 100. Id., Fig. 11A, step 1104; and page 16, lines 33-34. Subscription type information is received that includes at least one of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period. Id., Fig. 11A,

step 1116; page 17, lines 5-27. Pay-out instructions are received that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description. Id., page 17, lines 28-31, page 9, last full paragraph. Notification is sent to the payor 110 after receiving the pay-out instructions. Id., Fig. 11B, step 1148; and page 17, last paragraph. A period of time is waited between sending notification and transferring the transfer amount from the stored value fund to the payee 130. Id., Fig. 11B, step 1140; and page 17, lines 31-32. The second-listed transferring step can be cancelled if the payor 110 declines within the period of time. Id., Fig. 11B, steps 1152 and 1160; and page 17, lines 31-34.

Claims 10, 16 and 20 are Beauregard claims that have limitations that track their parent claims described above. These claims use the method implemented in computer-executable instructions and embodied on a computer-readable medium.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground I: Claims 10, 11, 16, 17 and 20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Office Action, paragraphs 4-5.

Ground II: Claims 1-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over cited portions of U.S. Patent No. 5,920,847 issued to Kolling et al. ("Kolling") in view of U.S. Patent No. 6,408,284 issued to Hilt et al. ("Hilt"). Office Action, paragraphs 6-7.

7. ARGUMENT

I. Ground I: §112 Rejection of Claims 10, 11, 16, 17 and 20

The Office Action rejects claims 10, 11, 16, 17 and 20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claims 10, 16 and 20

The Examiner takes the position that these are independent claims. Each of these claims refers back to another claim. 37 C.F.R. 1.75(c) states "One or more claims may be presented in dependent form, referring back to and further limiting another claims or claims in the same application." This rule defines what is dependent form to mean a claim that refers back and further limits a claim. Claims 10, 16 and 20 all refer back to another claim and limit the method to Beauregard format that requires a computer-readable medium. Accordingly, Appellant believes these claims are dependent claims.

Claim 17

The Examiner takes the position that a "second-listed transferring step" is unclear. Method claims list steps. Claim 17 includes two steps that begin with the word "transferring" and are commonly referred to as "transferring steps." Where there are two "transferring steps," reference to the "transferring step" can be unclear. Through the process of writing out claims, all claims must list steps in sequential fashion. This serial relationship of the steps lends itself to referencing steps with the same name as first-listed, second-listed, third-listed, etc. Appellant is perplexed at how there could be any ambiguity when reference is made to the "second-listed transferring step" in claim 17 that lists the steps sequentially in a list.

Claim 11

The Examiner believes there is ambiguity between the two different terms of "handler" and "second handler" in claim 11. As best understood by the Appellant, the Examiner apparently thinks both of these terms refer to the same thing. This interpretation seems unreasonable as these terms are different. By putting a modifier (i.e., "second") before a the common noun in these terms (i.e., "handler"), grammar dictates the writer must be referring to something else. Appellants believe contrary interpretations would be unreasonable.

II. Ground II: §103(a) Rejection of Claims 1-27

The Office Action rejects claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over cited portions of U.S. Patent No. 5,920,847 issued to Kolling et al. ("Kolling") in view of U.S. Patent No. 6,408,284 issued to Hilt et al. ("Hilt"). Appellant believes a *prima facie* case of obviousness has not been properly set forth in the final Office Action with regard to a rejection of claims 1-27. The patent office is charged with putting forth a *prima facie* showing of obviousness. The basic test is excerpted below:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

Appellant believes that the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness for the various claims as explained below.

Teaching Missing from Claims 1-27

With regard to the third prong of the test, Appellant believes that Kolling and Hilt do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, none of Kolling and Hilt teach or suggest: transfer of money from the handler to a stored value fund and transfer from the stored value fund to the payee as generally required by

claims 1, 11, and 17. For least this reason, Appellant respectfully requests overturning the rejection of the claims.

The claims generally require two transfers through a stored value account. One transfer from a handler to a stored value account and another from the stored value account to the payee. Kolling is apparently cited in the Office Action for both transfers. Office Action, page 3, last paragraph through page 4, line 2. Kolling is a bill payment system that transfers money in a single transaction from a consumer 12 to a biller 14. Further, Kolling and Hilt teaches use of a settlement bank 128 between the payor bank 16 and the payee bank 18, but the settlement bank 128 of Hilt and Kolling is not a stored value fund as is claimed. Neither the payor or payee have access to the settlement bank 128 such that it cannot act as a stored value fund. The settlement bank 128 is merely a clearinghouse used by banks as an intermediary when performing a single transfer.

The difference is best illustrated by an example, within the scope of the claims. The payor 110 might use a bank handler 160-4 to add money to the stored value fund. This process would typically use settlement banks to clear that first transfer. The payee 130 could also use a bank handler 160-4 to get funds out of the stored value fund. This would also require settlement banks. This clearly illustrates how Hilt and Kolling perform a single transfer, but the claimed invention requires two transfers. Use of the intermediary stored value fund has tremendous advantage in insulating both parties from the details of the other party's handler 160.

Teachings Missing from Claims 17-22 and 27

In addition to the missing limitation in preceding sub-section, claim 17 has further limitations not taught in Kolling or Hilt. More specifically, none of Kolling and Hilt teach or suggest: waiting a period of time after a notification and before transfer as required by claim 17. For least this reason, Appellant respectfully requests overturning the rejection of the claims.

Appellant does not clearly understand the Office Action's rational for Hilt teaching the above concept. Office Action, page 6, mid-second paragraph. The Office Action cites Hilt, col. 1, lines 60-63, for the time period and col. 11, lines 56-63 for the notification. Col. 1, lines 60-63 has nothing to do with a time period and is the background section of the application. Col. 11, lines 56-63 relate to a payment message send by the payor bank and payment reversal messages presumably sent by a payor. The limitation in claim 17 is "sending notification to the *payor*." It is not clear how Hilt can be used in this way.

Claim 17 waits a period of time to allow the payor to decline the transfer before it is initiated. The claim requires waiting a period of time *before* transfer, but Hilt initiates the transfer first and then allows it to be reversed for a period of time with a "payment reversal message." Hilt, col. 11, lines 56-58. This difference in Hilt requires reversal of a transfer, which is a risky proposition. Electronic clearing of checks today allows the administrative period in which a transfer is pending can be virtually non-existent such that reversal without risk of loss is great for a payor bank hoping for a reversal.

Additionally, online stored value funds are dependent on money handlers for in-transfers and out-transfers to many different types of handlers. Some of these handlers do not allow reversal of a transfer. For example, an agent handler 160-5 can provide cash seconds after the transfer. Once that cash is picked-up, there is little likelihood reversal would be effective. Claim 17 avoids this problem by having the waiting period before the transfer.

Motivation to Combine Kolling and Hilt for All Claims

The first prong of the test requires, a suggestion or motivation to combine references to avoid hindsight reconstruction of the claimed invention based upon the information disclosed in the present application. The last sentence of the first full paragraph on page 4 of the

Office Action appear to address the motivation to combine Kolling and Hilt, but Appellant cannot discern the nature of this argument. It is not clear if Official Notice is being relied upon or if the Appellants specification is being used in an attempt at hindsight reconstruction.

Apparent Official Notice for All Claims

The Examiner cites no reference when providing a motivation to combine Kolling and Hilt. Office Action, page 4, first full paragraph, last sentence; and page 6, last full paragraph, last sentence. By not citing any reference for this motivation, Appellants can only presume that Official Notice is the basis for the motivation. An express showing of documentary proof is hereby requested to support this stated motivation as the documentary proof procedure is set forth in MPEP §2144.03.

Hindsight Reconstruction for All Claims

The only way this combination of Kolling and Hilt makes any sense is to use the Appellant's claims as a template, which is impermissible hindsight reconstruction. Specific motivation relevant to convoluted combination of the claimed limitations is respectfully requested in any further decision or office action.

Claims 1 and 11

With regard to claims 1 and 11, the Examiner stated rational motivation the combination is that it "would allow Kolling to have a bill paying system that pays a set amount of money at periodic intervals after identifying the payee." This motive seems to be guided solely on what is claimed and seems to appear nowhere in Kolling or Hilt. Use of the claims as a template when combining elements is impermissible hindsight reconstruction.

Claim 17

In providing motive to reject claim 17, a similar rationale is given. More specifically, the stated motivation is that "a modification would allow Kolling to have the capability to send a message to a payor after receiving the payment message if sent within some

period after the payment message for the transaction." Once again that motive seems to be derived solely from the invention of claim 17 without any independent guidance that would push one of ordinary skill in the art to build the claimed invention from Kolling and Hilt.

Reasonable Likelihood of Success in Combining Kolling and Hilt

The second prong of the test requires a reasonable likelihood of success in making the combination suggested by the Examiner. Combining Kolling and Hilt is confusing to explain, at best, and requires non-intuitive modifications to each reference. Indeed, even within each reference, the Examiner seems to pick and choose elements from different embodiments. Such major modifications these references without any guidance or motive would have little likelihood of success.

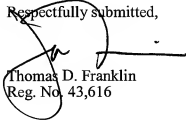
For at least the forgoing reasons, Appellant believes any obviousness rejection of claims 1-27 is believed improper.

8. CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the Office Action dated September 9, 2004. No requisite fee believed required as this brief reinstates the former appeal, but if this understanding is incorrect, please deduct the requisite fee from deposit account 20-1430 and any additional fees associated that may be due in association with the filing of this supplemental brief.

If for any reason the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned attorney at (303) 571-4000.

Respectfully submitted,


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9. CLAIMS APPENDIX

1. (Original) A method for automatically processing a recurring transfer request from a stored value fund with an online system, the method comprising:
determining a handler associated with a payor;
transferring money from the handler to the stored value fund;
informing the payor that a payee accepts payment from the online system;
receiving subscription type information which includes at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period;
receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description; and
transferring the transfer amount from the stored value fund to the payee automatically.

2. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step comprises transferring the transfer amount to a second stored value fund associated with the payee.

3. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions.

4. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step comprises transferring the transfer amount to a second handler associated with the payee.

5. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 4, wherein the second handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer.

6. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program.

7. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, further comprising a steps of:

- sending notification to the payor after receiving the pay-out instructions;
- waiting a period of time between the sending step and the second-listed transferring step;
- canceling the second-listed transferring step if the payor declines within the period of time.

8. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the transfer amount corresponds to at least one of: currency, monetary value, airline mileage, promotional program points, gift certificate credit, and commodities.

9. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the payor, the handler and the payee are remotely located with respect to each other.

10. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the recurring transfer request from the stored value fund with the online system of claim 1.

11. (Previously Amended) A method for automatically processing a transfer request from a stored value fund with an online system, the method comprising:
determining a handler associated with a payor;
transferring money from the handler to the stored value fund;
informing the payor that a payee accepts payment from the online system;
receiving subscription type information which includes at least one of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period;
receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description; and
transferring the transfer amount from the stored value fund to a second handler associated with the payee automatically.

12. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions.

13. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, wherein the second handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer.

14. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, wherein the

handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program.

15. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, further comprising a steps of:

- sending notification to the payor after receiving the pay-out instructions;
- waiting a period of time between the sending step and the second-listed transferring step;
- canceling the second-listed transferring step if the payor declines within the period of time.

16. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the transfer request from the stored value fund with the online system of claim 11.

17. (Original) A method for automatically processing a transfer request from a stored value fund with an online system, the method comprising:

- determining a handler associated with a payor;
- transferring money from the handler to the stored value fund;
- informing the payor that a payee accepts payment from the online system;
- receiving subscription type information which includes at least one of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period;
- receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description;
- sending notification to the payor after receiving the pay-out instructions;
- waiting a period of time between the sending step and the second-listed transferring step;
- transferring the transfer amount from the stored value fund to the payee; and

canceling the second-listed transferring step if the payor declines within the period of time.

18. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions.

19. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step comprises transferring the transfer amount to a second handler associated with the payee.

20. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the transfer request from the stored value fund with the online system of claim 17.

21. (Previously Presented) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step comprises a step of transferring the transfer amount in a plurality of transfers.

22. (Previously Presented) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, further comprising a step of checking the pay-out instructions against the subscription type information.

23. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the determining step comprises a step of determining by the online system a handler previously associated with a payor.

24. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the stored value fund is hosted by the online system.

25. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the receiving steps receive information online at the online system.

26. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, further comprising a step of determining if the transfer amount violates any limits specified in the subscription type information.

27. (Previously Presented) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the fixed payment amount is a per-request limit.

10. EVIDENCE APPENDIX

None

11. RELATED PROCEEDINGS APPENDIX

None